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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,429	10/24/2005	Adrian David Lincoln	P08620US02/BAS	8445
881 7590 01/21/2009 STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			EXAMINER HENNING, MATTHEW T	
			ART UNIT 2431	PAPER NUMBER
			MAIL DATE 01/21/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/531,429

**Applicant(s)**

LINCOLN ET AL.

**Examiner**

MATTHEW T. HENNING

**Art Unit**

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-26 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

This action is in response to the communication filed on 4/15/2005.

**DETAILED ACTION**

Claims 1-26 have been examined.

***Title***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Information Disclosure Statement***

The information disclosure statement(s) (IDS) submitted on 4/15/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

***Drawings***

The drawings filed on 4/15/2005 are acceptable for examination proceedings.

***Specification***

The abstract of the disclosure is objected to because:

The abstract contains trademarks which have not been identified properly.

Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

The disclosure lacks section headings.

The use of the trademark WINDOWS has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

The examiner encourages the applicants to carefully check the specification to ensure that no other trademarks have been used without proper capitalization and accompaniment by the generic terminology.

#### ***Claim Objections***

Claims 13-26 are objected to because of the following informalities:

Claim 13 misspells the word "registerable".

Claim 22 recites "by data processing apparatus after" in line 1, but should recite "by a data processing apparatus after".

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

Claims 1-6, 9, 11-16, 20-24, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohashi et al. (US Patent Number 5,761,309) hereinafter referred to as Ohashi.

Regarding claim 1, Ohashi disclosed a method for carrying out an authentication process for authenticating a subsequent transaction by any one of a plurality of users with data processing apparatus (client) (Ohashi Abstract), including the step during the authentication process of operatively associating with the data processing apparatus a selected one of a plurality of authentication storage means (smart card) respective to the users, each authentication storage means storing predetermined authentication information and being registerable with a common telecommunications system for which the users have respective telecommunications terminals (Ohashi Col. 12 Lines 19-29), and the step of carrying out the authentication process via a communications link with the common telecommunications system (Ohashi Col. 12 Lines 30-36), the authentication process being carried out by authenticating means incorporated in the telecommunications system and involving the use of the predetermined authentication information stored by the selected one authentication storage means (Ohashi Col. 12 Lines 30-36), the predetermined authentication information stored by each authentication storage means corresponding to information which is used to authenticate that user's telecommunications terminal in relation to the telecommunications system (Ohashi Col. 12 Lines 30-36) but the authentication process for authenticating the transaction by that user with the data processing apparatus not requiring use of that user's telecommunications terminal nor requiring the telecommunications terminal to be actually authenticated by that information in relation to the telecommunications systems (Ohashi Col. 5 Paragraph 2).

Regarding claim 13, Ohashi disclosed data processing apparatus in combination with a selected one of a plurality of authentication storage means which are respective to users and are each for storing predetermined authentication information relating to the carrying out of an

1 authentication process for authenticating a subsequent transaction by the users with the data  
2 processing apparatus (Ohashi Col. 12 Lines 1-29), the authentication storage means all being  
3 registrable with a common telecommunications system for which the users have respective  
4 telecommunications terminals (Ohashi Col. 12 Lines 19-29), the authentication storage means  
5 when operatively associated with the data processing apparatus being operative to carry out the  
6 authentication process via a communications link with that system (Ohashi Col. 12 Lines 30-36),  
7 the authentication process being carried out by authenticating means incorporated in the system  
8 and involving the use of the predetermined information stored by the selected one authentication  
9 storage means (Ohashi Col. 12 Lines 30-36), the predetermined authentication information  
10 stored by each authentication storage means corresponding to information which is used to  
11 authenticate that user's telecommunications terminal in relation to the telecommunications  
12 system (Ohashi Col. 12 Lines 30-36) but the authentication process for authenticating the  
13 transaction by that user with the data processing apparatus not requiring that use of user's  
14 telecommunications terminal nor requiring the telecommunications terminal to be actually  
15 authenticated by that information in relation to the telecommunications system (Ohashi Col. 5  
16 Paragraph 2).

17 Regarding claim 22, Ohashi disclosed a data carrier (Card Reader) carrying data for use  
18 in and by data processing apparatus after an authentication process involving the use of the data  
19 processing apparatus and separate authenticating means (Ohashi Col. 12 Lines 1-36), the data  
20 carrier also incorporating authentication storage means (Smart Card) storing predetermined  
21 authentication information respective to a user (Ohashi Col. 12 Lines 19-29), the authentication  
22 storage means being registered with a telecommunications system which includes the

1 authenticating means and for which the user has a telecommunications terminal (Ohashi Col. 12  
2 Lines 19-29), the authentication storage means being responsive to an input message for deriving  
3 a response dependent on the input message and on the authentication information for enabling  
4 the authenticating means to carry out the authentication process via a communication link with  
5 the authenticating means in the said system whereby to authenticate a subsequent transaction by  
6 the user with the data processing apparatus and which involves use of the data carried by the data  
7 carrier (Ohashi Col. 12 Lines 1-36), the predetermined authentication information stored by the  
8 authentication storage means corresponding to information which is used to authenticate the user  
9 registered with the telecommunications system in relation to use of that user's  
10 telecommunications terminal in the telecommunications system (Ohashi Col. 12 Lines 30-36),  
11 but the authentication process for authenticating the transaction by that user with the data  
12 processing apparatus not requiring use of the user's telecommunications terminal nor requiring  
13 the telecommunications terminal to be actually authenticated by that information in relation to  
14 the telecommunications system (Ohashi Col. 5 Paragraph 2).

15 Regarding claim 2, Ohashi disclosed that the authentication storage means is associated  
16 with the data processing apparatus by being associated with data or software for use by that data  
17 processing apparatus (Ohashi Col. 5 Paragraphs 2-3).

18 Regarding claim 3, Ohashi disclosed that the authentication storage means is incorporated  
19 on a data carrier for the data or software (Ohashi Col. 5 Lines 65-67).

20 Regarding claims 4, and 14, Ohashi disclosed that the authentication storage means  
21 includes processing means (Ohashi Col. 11 Lines 18-24).

Regarding claims 5, 15, and 23, Ohashi disclosed that each user is authenticated in the telecommunications system by means of the use of a smart card or subscriber identity module, and in which the authentication storage means respective to that user corresponds to or simulates the smart card for that user (Ohashi Col. 12 Lines 1-36).

Regarding claims 6, and 16, Ohashi disclosed that the authentication process involves the sending of a message and the generation of a response dependent on the message and the predetermined information (Ohashi Col. 12 Line 55 – Col. 13 Line 10).

Regarding claim 9, Ohashi disclosed that the data processing apparatus is a personal computer (Ohashi Col. 5 Paragraph 2).

Regarding claims 11, 20, and 26, Ohashi disclosed that the authentication storage means is one of a smart card and SIM that is operable to authenticate the user's telecommunications terminal for use in the system (Ohashi Col. 12 Lines 1-36).

Regarding claims 12 and 21, Ohashi disclosed that the authentication storage means is provided with a carrier coupleable to the data processing apparatus (Ohashi Col. 5 Paragraph 2).

Regarding claim 24, Ohashi disclosed that the data carried by the data carrier includes software (Ohashi Col. 4 Lines 64-66).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*



Claims 7-8, 10, 17-19, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohashi.

Regarding claims 7-8, and 17-18, while Ohashi disclosed providing a network service, Ohashi fails to disclose the system levying a charge for the service transaction. However, it was well known in the art of service providing to levy charges for providing the service. As such, it would have been obvious to the ordinary person skilled in the art at the time of invention to have had the system levy a charge for the service. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the service provider with compensation for the service.

Regarding claims 10, 19, and 25, while Ohashi disclosed the smart card communicating with a smart card reader, Ohashi failed to disclose the communication being wireless. However, it was well known at the time of invention for smart cards to communicate wirelessly. As such, it would have been obvious to the ordinary person skilled in the art at the time of invention to have provided the communications wirelessly. This would have been obvious because the ordinary person skilled in the art would have been motivated to increase the ease of use for the user.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No. 10/531,430, and all pending claims of copending Application No. 10/574,808. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims of the copending applications are merely well known variations of the SIM authentication protocol and the use of SIM cards. As such, the ordinary person skilled in the art at the time of invention would have found the differences between the copending applications obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Claims 1-26 have been rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW T. HENNING whose telephone number is (571)272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew T Henning/  
Examiner, Art Unit 2431